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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,320	11/25/2003	Warren P. Heim	40197-00538	9459
25231	7590	02/01/2006		
MARSH, FISCHMANN & BREYFOGLE LLP 3151 SOUTH VAUGHN WAY SUITE 411 AURORA, CO 80014			EXAMINER PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/723,320

Applicant(s)

HEIM ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-36 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Drawings***

It is noted that Figure 16A contains a "Prior Art" label. It is apparent from the specification that Figure 16A is the embodiment being claimed in the instant applications claims. Further, the specification does not specifically address Figure 16A as "Prior Art", but rather discusses Figure 16A with respect to being a preferred embodiment. For the purposes of examination, the "Prior Art" label of Figure 16A is deemed to be an error, and applicant is required to submit a corrected Figure 16A. Otherwise, Figure 16A could be deemed as admitted prior art in a 35 USC 102 rejection.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 14-17, 21-23, 27-32, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al (5,891,095).

Eggers et al disclose an electrosurgical assembly comprising an output assembly (26) connectable with a generator (Figure 16), an active electrosurgical element (12) including one or more active electrodes connected with the output assembly, and a return path element (17) mechanically connected to the active element to define a bipolar configuration. The active element (12) and return element (17) are at different locations on the device and interact with different portions of tissue in use. A first dielectric component (18) interfaces with the patient and surrounds the return element along a substantial portion of its length. The return path element also includes a return assembly (one of the leads connected to plug 26 in Figure 16) for connecting the return element to the generator. The Eggers et al active electrode may be a single electrode or a plurality of electrodes, and the electrode(s) may include a variety of shapes (Figures 12-15). The examiner maintains that the dielectric coating is inherently capable of withstanding the voltages recited in the claims, particularly since Eggers et al

disclose the use of voltages within that range and the dielectric is provided to protect tissue.

With regard to claims 14-17, Eggers et al fail to disclose the specific impedance of the return path element. However, in as much as the return path element is an electrically conductive tubular member made of a conductive metal (col. 11, lines 17-20), it is deemed to inherently possess a very low impedance within the range set forth in these claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-13 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al ('095) in view of the teaching of Long et al (6,106,519).

Eggers et al disclose the use of a dielectric to coat the tubular member that serves as the return electrode, but fails to disclose a specific material that has a dielectric product as set forth in these claims. It is noted that Eggers et al disclose the use of various dielectric materials for making the device, including polyimides and ceramics.

Long et al disclose another bipolar electrosurgical apparatus and specifically teach of the use of Barium Titanate as a dielectric material (col. 5, lines 4-6). In as much as Barium Titanate is the identical material used in the instant application, it is

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deemed to have identical properties for dielectric constant. Further, the thickness of the insulating layer disclosed by Long et al and/or Eggers et al is deemed to inherently yield a dielectric product as set forth in the claims.

To have used any well known dielectric coating to provide an insulating layer on the Eggers et al device would have been an obvious design consideration for one of ordinary skill in the art, particularly in view of the teaching of Long et al.

Claims 18-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al ('095) in view of the teaching of Stern (6,413,255).

While Eggers et al disclose a dielectric material (i.e. insulator) surrounding a majority of the return path element, the distal-most portion is left uncovered and energy is not return to the generator "through" the dielectric as set forth in claims 18-20.

Stern discloses another bipolar electrosurgical apparatus that includes active and return electrodes disposed at the distal end of the device. In particular, Stern teaches of providing both the active and return electrodes with a dielectric coating to as to provide a more uniform distribution of energy across the electrode surfaces.

To have provided the Eggers et al device with a dielectric coating on the entire surface of the return electrode to provide a more uniform distribution of the return electrode would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Stern.

Claims 24 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al ('095) in view of the teaching of Goble et al (6,228,081).

Eggers et al fail to specifically disclose the use of a capacitor or a shunt circuit in the return path of the electrosurgical device.

Goble teaches of the known use of isolation capacitors (68) and shunt circuits provided in return paths to better control the delivery of RF energy to an electrode assembly.

To have provided the Eggers et al device with a capacitor and/or shunt circuit in the return path to better control the delivery of energy to/from the generator would have been an obvious consideration for one of ordinary skill in the art in view of the teaching of Goble.

#### ***Allowable Subject Matter***

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

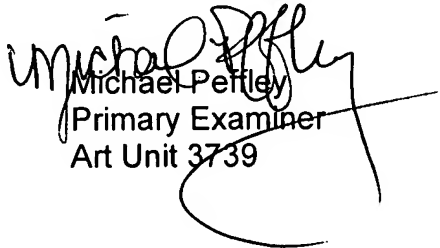
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goble et al (6,758,846) discloses a bipolar electrosurgical system that includes a return electrode coated with a dielectric.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Perley  
Primary Examiner  
Art Unit 3739

mp  
January 27, 2006